

IN THE  
**United States Circuit Court of Appeals**  
FOR THE NINTH CIRCUIT

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NATIONAL MOTOR BEARING CO., INC.,  
a Corporation,  
*Appellant-Plaintiff,*  
vs.

CHANSLOR & LYON CO., a Corporation,  
*Appellee-Defendant.*

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**BRIEF FOR APPELLEE.**

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NO. 11,631

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*Appellee-Defendant.*

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**BRIEF FOR APPELLEE.**

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**Statement of the Case.**

This is a patent infringement case. The Trial Court held the single claim of the patent in suit invalid on each of two grounds—lack of novelty, and lack of invention. (Memorandum Decision, R. p. 37; Findings of Fact and Conclusions of Law, R. p. 56; Judgment, R. p. 60).

The Appellant (the plaintiff below) urges error in Findings of Fact VI, VII, and VIII and in Conclusions of Law II, III, and IV. The legal conclusions (the patent is invalid for lack of novelty, the patent is invalid for lack of invention, and the complaint should be dismissed), are unquestionably sound if the fact findings are taken as true. Thus, there is presented no alleged error of law, but merely



alleged errors of fact. It is to be noted that the Findings of Fact are not those proposed by the parties, but were prepared by the Trial Court, itself (R. p. 56). Thus, Rule 52(a) of the Rules of Civil Procedure, which provides that "Findings of Fact shall not be set aside unless clearly erroneous . . .", applies with special force to the instant case.

The facts found by the Trial Court, any one of which supports a legal conclusion of invalidity, are (R. pp. 57-58):

1. The structure of the Johnson claim was disclosed by the prior art patent to Chandler, No. 1,905,800;

2. The structure of the Johnson claim was disclosed by the prior art patent to Fitzgerald No. 1,983,746.

3. The structure of the Johnson claim was disclosed by the prior art patent to Gits No. 2,052,762.

4. The structure of the Johnson claim was disclosed by the prior art patent to Heinze No. 2,071,403.

5. The structure of the Johnson claim was disclosed by the prior art patent to Winter No. 2,089,461.

6. Johnson was not the original, first and true inventor or discoveror of the alleged invention or any material or substantial part thereof.

7. The structure claimed by Johnson was in public use and on sale more than two years prior to Johnson's application.

8. There was no invention in what Johnson claimed, and nothing more than ordinary mechanical and engineering skill and practice.

It will be pointed out hereinafter, that none of these fact findings are clearly erroneous, and that each is fully supported by the evidence. Further, it will be pointed out that although the Trial Court did not pass on the question of infringement, since the accused structures, themselves, were on sale prior to the filing of Johnson's patent application the patent cannot be both valid and infringed. An additional defense, which developed on the reopening of the proofs (on motion of the plaintiff) and which was not decided by the Trial Court, is that if there had been an invention, it was the invention of one Klein or at least a joint invention of Johnson and Klein and the patent to Johnson, as sole patentee, is void.

## ARGUMENT.

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### The Disclosure and Claim of the Johnson Patent.

(Appellant's Opening Brief pp. 5-9)

The Johnson patent No. 2,146,677 (R. p. 513) relates to a mechanically simple structure. Sufficient details of the disclosed structures appear at pp. 6 and 7 of Appellant's Opening Brief. However, in order to show what Johnson's alleged invention was, a brief analysis of his disclosure and claim is required.

The first portion of the specification is devoted to calling attention to features said to be objectionable in prior oil seals. Seals using felt as the sealing member are unsatisfactory because the felt acts like a wick and draws oil (R. p. 513, col. 1, lines 3-14). Seals using leather for the sealing element, though widely used, present difficulties in securing the sealing member in a leak-tight, non-rotative fit. Also, as the leather becomes softened by the action of the oil, a greater sealing surface is brought into contact with the moving part, resulting in greater friction. Also, leather is not uniform in texture; therefore, a large sealing edge must be in contact with the movable shaft. This also results in greater friction. Finally, the lack of uniformity of leather presents manufacturing problems (R. p. 513, col. 1, lines 15-36).

Fluid seals made of rubber or composition with reinforcing means embedded near the outer rim expand as a result of frictional heat, thereby developing greater friction and more heat until the units are compressed beyond their elastic limit, and on cooling shrink and leak. Further "cold flow" is a problem with a composition or rubber seal (R. p. 513, col. 1, lines 37-52).

The patent continues with a statement that these and other defects present a problem in the newer and faster automobiles and other machinery which operate with so much higher shaft speeds. There are five stated objectives, the most specific of which is the first (R. p. 513, col. 2, lines 3-10):

“to combine the good features of the metal encased seal and of the composition seal, to provide a fluid seal having a metal or rigid heel portion and a sealing lip made of composition material in which the bearing area of the sealing lip on the movable part is small, resulting in low frictional resistance and cool operation.”

The patent continues with a description of the six different modifications illustrated. The form shown in Fig. 1 consists of four parts. There is an outer cup 8 having a radial wall 17. Secured to both sides of the radial wall is the sealing element 7. A garter spring 11 is placed in a groove 16 in the sealing element. An inner cup or cage 10 completes the assembly.

Fig. 2 shows substantially the same structure as shown in Fig. 1 except that instead of securing the sealing member 7 to both sides of a flange on the outer cup, the sealing element is clamped between a washer and the radial wall of the cup.

The other Figures contain minor variations, but fundamentally consist of the same structure.

After describing each of the modifications, the specification points out that by using an oil resisting composition material, which is consistent in texture, only a short shaft contacting surface is required (R. p. 515, col. 1, lines 4-7). This is, of course, to be contrasted with the earlier statement in the patent (R. p. 513, col. 1, lines 29-32) that a leather sealing element requires a large contacting surface.

The patent continues (R. p. 515, col. 1, lines 8-13) by pointing out that a composition such as Duprene is not affected by oil and so the garter spring cannot pull the long axial portion of the seal edge onto the shaft and thereby increase the friction. Again, this is to be contrasted with leather which in an earlier portion of the patent is said to have this disadvantage (R. p. 513, col. 1, lines 22-29).

In thus reading the disclosure, one is lead to believe that Johnson's invention is, as he states it, to combine the good features of the metal-encased seal and of the composition seal. Another way of stating the alleged improvement is the substitution of a composition sealing member, which is uniform in texture and oil-resistant, for the leather sealing member, which is not uniform in texture and which becomes more pliable as it absorbs oil.

On the mere statement of what the alleged improvement was, one recognizes that there could be no invention in substituting a known material, with known properties, for another material with known properties.

“Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put into the last opening in a jig-saw puzzle. It is not invention.” *Sinclair Co. v. Inter-Chemical Corp.*, 325 U. S. 327, 335 (1945), opinion by Mr. Justice Jackson.\*

“Patentees are not entitled to a monopoly for the judicious use of materials the use of which would produce the result to be expected from such selection. Recognition is not invention.” *Kalich et al v. Paterson Pacific Parchment Co.*, 137 F. (2d) 649, 651 (C. C. A. 9, 1943). Opinion by Judge Garrecht.

After repeated rejections, Johnson's application was allowed with a single claim which bears little relation to the

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\* The relevance of this decision is urged by plaintiff (Appellant's Opening Brief, p. 26).



original objectives. For convenience we break this claim into elements:

An oil seal of the type adopted for insertion to seal the annular space between the shaft and a bore in a housing, comprising

a cup member

having a peripheral portion and an axially inwardly offset radial flange,

a molded resilient sealing member

bonded to both sides of said radial flange at said offset so that its outer radial face lies within the radial plane of the cup bottom where it bends inward to form said offset,

whereby said molded material is protected from wear by contact with adjacent moving parts.

Two things in this claim should be noted particularly. First, the sealing element is not defined as made of "composition material", about which the specification speaks. The claim defines the material only in the phrase "a molded resilient sealing member." This is not limited to a composition material; but will include leather, as Johnson testified (R. p. 102).

The second notable portion of the claim is the final "whereby" clause. This clause had no counterpart in any of the claims of the application. It appeared for the first time in the claim submitted in the final amendment (R. p. 632).

This claim is far from the conception of the specification. The contribution alleged in the specification, of using a composition sealing element in place of leather in a metal cup member, is abandoned. The claim reads on a leather sealing element. The emphasis in the claim is on providing

a rim on the cup which extends beyond the sealing element to protect it from moving parts. This idea—like the original idea of Johnson—is old, as will be shown hereinafter.

The plaintiff alleges two features of the patent in suit (Appellant's Opening Brief, p. 9): "Cold Flow" is said to be prevented, and the sealing member is said to be protected from adjacent moving parts by having the cup member extend beyond it.

**Johnson Did Not Solve the "Cold Flow" Problem** (Appellant's Opening Brief, pp. 9, 16, 19, 22, 24, 31, 32).

Some synthetic materials differ from natural rubber in exhibiting more of a tendency to take a permanent set when under pressure. The change in shape which may result from pressure is known in the art as "cold flow." The plaintiff argues that Johnson, by cementing the sealing element to the flange of the cup instead of clamping it, produced a seal which "is not subject to cold flow." There is no evidence supporting this assertion. On the contrary the plaintiff represented in its motion to re-open proofs (R. p. 26) that the change in shape of the Johnson seals, exhibits 21 and 22, had been caused by cold flow. A similar representation was made in the affidavit by plaintiff's counsel in support of the motion (R. p. 22). Approximately one-fifth of the testimony in this case is testimony adduced by the plaintiff, itself, on the reopening of proofs in order to prove that the seals made by Johnson had "cold flow" (R. pp. 400-500). Plaintiff's Director of Research, Stewart, proved that the material used in the Johnson seals, plaintiff's exhibits 21 and 22, was subject to so much cold flow that seals made of it could not stay within tolerances for more than a few minutes (R. pp. 494-495). In its Brief in this Court, the plaintiff calls attention to and relies upon the cold flow which took place in the Johnson seals (Appellant's Opening Brief, p. 13).

The "cold flow", as to which there is proof in the record, is a flow resulting from the pressure of the garter spring on the seal. This flow was so marked that even though plaintiff's exhibits 21 and 22 were said to have originally been made to conform to the claim of the patent, by the time they were introduced in evidence the sealing element projected beyond the rim on the cup and the seals did not come within the claim (R. p. 271). When plaintiff speculates about cold flow, plaintiff urges that there would be cold flow at the juncture of the sealing element and the cup, if the sealing element were clamped. There is no proof as to this. Plaintiff asserts that as a result of the cold flow, the seal would become loose. Even if this were so, Johnson did not solve the problem because the sealing element on plaintiff's exhibit 21, made by Johnson, loosened (R. p. 477, See Plfs. Ex. 21).

The plaintiff argues that "the pressure of the clamp is fatal" in the prior Gits seal. The evidence does not support this assertion but, in any event, if it did, Johnson did not improve upon it because Figures 2 and 4 of the Johnson patent show a composition sealing element clamped to the cup. These views are said to be mere modifications of Johnson's idea (R. p. 513, col. 2, lines 30-38). The single claim is not so worded as to exclude clamping and, if this were Johnson's invention, he failed to patent it.

The fact is that cold flow is a property which certain materials exhibit in greater degree than others. Thiokol, the material used by Johnson in his alleged reduction to practice, was particularly subject to cold flow (R. pp. 26, 460-463). Not all synthetic materials have as much cold flow. There was cross-examination of defendant's witness, Gits, as to cold flow (R. pp. 328-333). This seems to show that under certain conditions the material used by Gits, Koroseal, might cold flow, but in the tests of the Gits seals, the sealing member did not become loose and did not leak (R. pp. 338-339).

Appellant has not ever made any Johnson seals commercially. The only Johnson seals known are the samples made in 1935. These samples, as Appellant conclusively proved, were so subject to cold flow that even if originally made to respond to the claim of the Johnson patent, they were soon so warped by so called "cold flow" that they no longer conformed. Also, the sealing member became loosened from the cup member (R. p. 477). Under these circumstances it cannot be said that the District Court was clearly erroneous in failing to find that the Johnson patent solved the "cold flow" problem.

**Johnson Made No Contribution in Stating That the Cup Would Protect the Sealing Element from Wear by Contact with Adjacent Moving Parts (Appellant's Opening Brief pp. 8-9).**

The claim of the Johnson patent provides that the outer face of the sealing member should lie within the radial plane of the cup bottom "whereby said molded material is protected from wear by contact with adjacent moving parts." This language is relied upon by Appellant as a "feature which contributes to the success of the seal." The fact is that the Johnson seal has not been a success. Appellant excuses itself (Br. p. 4) by stating that it is not "in the field of selling composition seals." Appellant prefers to sell prior art seals made with leather sealing elements clamped in the metal cup with all of the alleged attendant disadvantages under a patent owned by another company, rather than to use its own Johnson patent (R. pp. 82-83, 100-102, 280-282, 522). This preference was so strong that in 1940 and 1941 when building two new large plants, Appellant put in equipment to make the prior art clamped leather seals rather than the Johnson seals here so highly extolled. (R. pp. 88-89).



Appellant argues that the Victor Company has made seals charged here to infringe and that these seals have been successful. It is unnecessary to deny this. What is the proof that the "protection" of the sealing member by the rim of the cup contributed "to the success of the seal"? The proof is all to the contrary. Neither Aukers (R. p. 186-187) nor Gammie (R. pp. 200-201) in all their experience in the industry (which has been continuous throughout the time that the accused seals have been sold) knew of an instance in which a Victor seal was used as a spacer or where any moving part except the shaft would be permitted to contact it. Further than this Aukers pointed out that any contact with a moving part other than the shaft would be ruinous. It would damage the seal and cause failure (R. pp. 187-188). This whereby-clause requiring that the rim of the cup protect the sealing element from wear by contact with adjacent moving parts was added by the final amendment and secured allowance (R. p. 632). In so far as an inwardly offset flange may protect the sealing element, the advantage was already available to the art in a plurality of patents (See, for example, Godley 1,040,308, R. p. 642; Chandler 1,905,800, R. p. 667; Fitzgerald 1,983,746, R. p. 671; Gits 2,052,762, R. p. 701; Heinze 2,071,403, R. p. 707; Winter 2,089,461, R. p. 714; Peterson 2,114,908, R. p. 724; Heinze 2,116,240, R. p. 727) and was not a contribution of Johnson.

**The District Court Properly Found that the Gits Patent No. 2,052,762 and the Gits Prior Use Fully Disclosed and Anticipated the Seal of Johnson's Claim (Appellant's Opening Brief pp. 18-19).**

Beginning in 1933 Gits worked with the B. F. Goodrich Co. and The Spicer Manufacturing Corp. to develop a sealing member of synthetic material for use with a cup member theretofore used by Gits with a leather sealing member.



Although The Spicer Manufacturing Corp. did not purchase from Gits, but decided to make its own seals, nevertheless, Gits did reduce to practice by April 16, 1934 and filed a patent application on December 17, 1935 which matured into patent No. 2,052,762 on September 1, 1936. In this story there are three separate structures each of which invalidates the Johnson patent. The sale by Gits of such seals using a leather sealing element (R. pp. 308, 544) invalidated because, as Johnson admitted on cross-examination (R. p. 102), a leather sealing element responds to the requirement of the claim that the sealing element be "a molded resilient sealing member." The second invalidating structure is the Gits seal using a synthetic material as a sealing member which was offered for sale on April 16, 1934 (R. pp. 299-300, 544). Both of these structures clearly anticipate the Johnson patent and were prior to any date claimed by him. The third anticipating structure, which is in substance the identical thing, is the patent application, itself, which was filed some months prior to Johnson's application (R. p. 703).

The Gits patent No. 2,052,762 was cited by the Patent Office. Rule 75 of the Patent Office provides that when an application is rejected on a patent "which substantially shows or describes but does not claim" the rejected claim, the applicant can make an affidavit carrying his date back of the prior patent. Johnson filed such an affidavit, alleging reduction to practice prior to the filing of the Gits patent application. Pursuant to this affidavit the Patent Office withdrew the Gits patent as a reference. Although Johnson endeavored to prove his reduction to practice in the instant case, he failed to do so as shown at pp. 21 to 25 hereof. Therefore, the Gits patent as well as the Gits prior use is prior art as to Johnson.

The Appellant (Appellant's Opening Brief pp. 18-19) endeavors to distinguish the Gits patent by reference to the long history of development of the Gits seal which was proved in some detail in this record. It is true that this development work with a synthetic material, which even then was not fully developed, and which was being used in an application such as this for the first time (R. p. 377), was accompanied by some failures. However, the fact that Gits encountered difficulties in his development work is no proof that he did not succeed. A number of samples were made and tested by installation in shock-absorbers where they were subjected to 4,000,000 to 5,600,000 reciprocating strokes and found "okay" (R. pp. 394-395). The seals were offered for sale on April 16, 1934 (R. pp. 299-300, 544). This constituted a statutory bar as it was more than two years prior to Johnson's filing date (R. S. 4886, 35 U. S. C. 31). The Gits seals with leather sealing members were sold by the thousands at least as early as 1933 (R. pp. 308, 544). This, likewise, constituted a statutory bar.

The Appellant argues that the difficulties encountered by Gits were difficulties caused by cold flow. The evidence does not support this assertion. While it is true that Tarbox testified that his company did not order Gits seals because "they were not satisfactory," the only specific objection he made was that, in some of the seals tested, the contact of the sealing member was too far from the lip (R. p. 393). He at no place testified to any leaking at the juncture of the sealing member and the metal cup where Appellant alleges it would occur. He at no time testified as to cold flow. It is also to be recalled that though Tarbox testified that the Gits seals were unsatisfactory, the reason that his company did not finally purchase from Gits was that his company decided to make its own seals to avoid getting mixed up with the Gits patents (R. pp. 379, 579-580).

Appellant's Opening Brief (pp. 18-19) also states that Gits admitted that the reasons his seals failed were that the sealing member was held in place by clamps and due to cold flow the synthetic sealing member loosened up and the seal would leak. The Record, pages 328-333, to which Appellant refers does not support the statement of Appellant. While Gits speculated under cross-examination as to what might happen with cold flow, his testimony as to leaking is unequivocal (R. pp. 338, 339). He there testified that in the tests he made the synthetic rubber member did not loosen. He also unequivocally testified that the seals themselves did not leak.

The complete response of each of the three Gits anticipating structures to the Johnson claim is shown by the chart opposite this page. The Gits seals using the leather sealing member and using the synthetic sealing member were made substantially like the seals shown in the patent (R. pp. 299-300, 307-308). It is respectfully submitted that the finding of fact by the District Court, that the Gits patent and the Gits prior use show all of the substance of the Johnson claim, is correct and that the Appellant has failed to show, as it must on this appeal, that these fact findings are "clearly erroneous."

**The District Court Properly Found that the Seal of Johnson's Claim Was Fully Disclosed by the Winter Patent No. 2,089,461, the Fitzgerald Patent No. 1,983,746, the Chandler Patent No. 1,905,800 and the Heinze Patent No. 2,071,403 (Appellant's Opening Brief pp. 14,17, 20).**

As shown above the Gits patent and the Gits prior uses each constitutes a clear anticipation of the single claim of the Johnson patent, as the Johnson claim reads verbatim upon those structures. There are a number of other prior art patents upon which the claim of Johnson also reads verbatim except for the single limitation that the sealing

element be secured to "both sides of" the radial flange. These additional prior art patents also anticipate the Johnson claim, since anticipation may be shown by a structure which has the identical or equivalent elements called for by the claim.

The principle that an anticipation may be shown by a structure which has equivalent, though not identical, elements is well illustrated by the decision of this court in *Daily v. Lipman, Wolfe & Co.*, 88 F. (2d) 362 (CCA 9, 1937). In that case, suit was brought upon a patent on a spring wire collar snubber. A prior device was similar and contained all elements of the claim except that the patent there in suit provided points to penetrate the shirt collar, whereas, the prior art device had studs which required previously formed holes in the fabric, such as eyes or button-holes. The Court pointed out that there would be anticipation if the points of the patent in suit performed the same function as the studs of the prior art device and if the points "were well known as a substitute for the studs." The Court then called attention to two patents, each of which disclosed penetrating points and stated that in view of them, the points in the plaintiff's patent were a well-known substitute for the studs. The patent in suit was held anticipated, the Court saying at page 365:

"Plaintiff contends that 'anticipation cannot be made out by constructing an hypothetical combination composed of individual elements selected from several examples of the prior art.' That rule has no application to this case, for our question is simply a question of equivalents."

In each of the patents to which reference will now be made an oil seal is shown upon which the Johnson claim reads verbatim, except for the limitation that the sealing element be secured to "both sides of" the radial flange.



As in the *Daily Case* referred to above, the question presented is one of equivalents. Broadly stated, the question is—what means were known to the art to secure a sealing member to a flange. More specifically, the question is whether clamping the sealing member by metal was the known equivalent of clamping the metal by the sealing member.

Two things are desired in securing the sealing member to the cup member: the two parts must be held together and oil must not be permitted to pass between them.

The art knew that this could be done in several ways:

- (1) By an adhesive (Peterson No. 2,114,908, R. p. 724);
- (2) By molding or vulcanizing the sealing member to the flange, with or without perforations to assist (Penick No. 1,817,095, R. p. 660; Lord No. 1,996,210, R. p. 675; Walker No. 2,028,634, R. p. 745; Miller No. 2,004,669, R. p. 692);
- (3) By clamping (Winter, No. 2,089,461, R. p. 714; Fitzgerald No. 1,983,746, R. p. 671 and others).

Each of these securing means performed the same function in substantially the same way with substantially the same result. Which one or ones might be used in a given instance depended upon the details of design of the particular seal and upon the preferred material of the sealing element. All three securing means were plainly equivalents and known to be such in the art.

In the Johnson patent, itself, one finds a recognition of this equivalency, as Johnson in his disclosure employed all three expedients. Johnson states that it is preferable to use cement to “insure a good bond” (R. p. 514, col. 1, lines 4-7). Johnson advised placing the cup member and the material for the sealing element in the mold and applying pressure to secure the parts (R. p. 514, col. 1, lines 9-11).



Johnson also used clamping (See Figs. 2 and 4, R. p. 512, R. p. 14, col. 1, lines 47-51). In his patent drawings (R. p. 512) Johnson shows in Figs. 1, 3 and 5 devices having a sealing member secured to both sides of a radial flange. In Figs. 2 and 4 Johnson shows the sealing member clamped between a washer and a flange on the cup. In the Specification (R. p. 514, col. 1, lines 54-58) Johnson states that the washer with the sealing element secured to one side of it may be used alone. The Johnson patent, itself, has termed these different expedients merely modified forms of the same thing (R. p. 513, col. 2, lines 30-38, R. p. 515, col. 1, line 18 to col. 2, line 1). As was so aptly stated in *Warner Bros. Company v. American Lady Corset Company*, 136 F. (2d) 93, 95 (1943) by the Circuit Court of Appeals for the Second Circuit:

“Having treated both forms of construction as equivalents, it would seem that anticipation of one would equally anticipate the other.”

Since the art and the Johnson patent, itself, treated cementing, molding, vulcanizing and clamping the sealing element to the cup as equivalents, they were properly so regarded by the District Court.

The complete and literal response of each of the four patents (Winter, Fitzgerald, Chandler and Heinze) to the Johnson claim, save for the manner of securing the sealing element to the cup, appears not to be denied. Johnson on the witness stand conceded this as to Chandler, Winter and Fitzgerald (R. pp. 247-248).

As to each of these patents, the Appellant (Brief pp. 16-17, 20) seeks to distinguish only on the ground that clamping the sealing element will cause cold flow and destroy the usefulness of the seal. This has been discussed hereinbefore. There is no proof and merely the speculation of Appellant as to it. The only devices shown by this record

to have been adversely affected by cold flow were the Johnson seals, plaintiff's exhibits 21 and 22.

Appellant (Brief, p. 17) states that the Chandler patent was cited against the Johnson application "and its irrelevancy established." An examination of the file wrapper and contents (R. p. 593 to 639) justifies appellant's statement that the Chandler patent was cited against the Johnson application. However, the file wrapper does not show that the alleged "irrelevancy" of the Chandler patent "was established." At R. p. 613 to which Appellant refers, Johnson's solicitor in April, 1937 argued that Gits and Chandler were not relevant because the sealing member is secured by means of clamping. This did not establish any alleged irrelevancy for on August 2, 1937 the Patent Office Examiner again rejected on the same references, the Examiner saying R. pp. 616-617:

"The vulcanized connection of Penick et al. and the clamped connection of Gits and Chandler, are both forms of a joining or bonding means, and the substitution of one for the other is held not to amount to invention."

At Record p. 627 to which Appellant also refers as authority for its assertion that the irrelevancy of the Chandler patent was established in the Patent Office, Johnson's solicitor again sought to distinguish the Chandler patent, but this did not establish its irrelevancy, for a few months later the Patent Office Examiner again rejected all claims on the patents to Chandler, Penick and Gits (R. p. 631). Johnson's solicitor responded with the final amendment by which all claims were cancelled and the final claim added. This amendment shows that there was "an interview kindly granted by the Examiner" (R. p. 633). Patent Office Rule 68 provides that where there has been an interview, the applicant "must file a written statement of the reasons presented at the interview as warranting favorable action."

Presumably, the rule was followed by Johnson's solicitor. In the remarks accompanying the final amendment attention is directed to affidavits under Rule 75 to overcome the reference to the Gits patent (R. p. 633). Nothing is said as to the Chandler patent. Thus, the file wrapper and contents of the Johnson patent not only do not support Appellant's assertion that the irrelevancy of the Chandler patent was established but, on the contrary, show Johnson never successfully distinguished the Chandler patent and was allowed the single claim only because at the interview and at the time of the final amendment, the Chandler patent was not mentioned.

**The Accused Seals Do Not Come Within the Johnson Claim and, in Any Event, Were Prior to Johnson so that His Claim Cannot Be at the Same Time Valid and Infringed** (Appellant's Opening Brief pp. 9-13).

The final clause of the Johnson claim reads:

“a molded resilient sealing member bonded to both sides of said radial flange at said offset so that its outer radial face lies within the radial plane of the cup bottom where it bends inward to form said offset, whereby said molded material is protected from wear by contact with adjacent moving parts.”

Appellant offered no proof that any accused seal was ever so used that this result was obtained. Appellant had the burden of proof on this, first, because in any case the plaintiff must show not only a literal response to a claim, but also that the accused structure functions like the claimed structure and accomplishes the same result. Moreover, where a claim specifies a manner of operation, the plaintiff must prove that it is performed.

In *Thompson Meter Co. v. National Meter Co.*, 106 F. 519 (CC, NY, 1900) the Court held a claim not infringed

which called for a combination of water meter parts and concluded "whereby the impact of the inflowing current upon the disk is decreased, substantially as set forth." The alleged infringer manufactured the claimed combination of elements but did not use the parts in the manner recited in the whereby clause. The Court held that infringement was absent (R. p. 530), "because as a matter of law it is settled that such a specific statement of function thus inserted into a claim as material cannot be disregarded." See also

*E. H. Freeman Electric Co. v. Weber Electric Co.*,  
262 F. 769 (CCA 3, 1919), affirmed 256 U. S.  
668, 65 L. Ed. 1162;

*Lovell v. Johnson*, 91 F. 160 (CCA 1, 1898)

Not only did the plaintiff fail to prove that any accused device functioned as called for by the claim, but plaintiff also failed to prove that any accused device could so function. The testimony of Aukers (R. pp. 186-188) and Gammie (R. pp. 200-201) showed that in all of their experience neither knew of an instance in which an accused seal was used as a spacer or was used where any moving part except the shaft would be permitted to contact it. Aukers further testified (R. pp. 187-188) that any contact with moving parts other than the shaft would so damage one of the accused seals that it would result in failure of the seal. The thin metal cup is ordinarily from 0.03 to 0.05 inches in thickness. (See Plf. Ex. 21 and 22 for example.) For this reason, and others, the defendant contested infringement in the Court below. The District Court did not pass upon the question. It is submitted that in view of plaintiff's failure of proof, infringement was not established. In any event, since the accused seals were offered for sale prior to Johnson's application (R. pp.



189-195, 768-770), the Johnson patent cannot at the same time be valid over, and infringed by, the accused structure.

At the trial the plaintiff endeavored to prove a reduction to practice in the fall of 1935. Johnson produced two seals, plaintiff's exhibits 21 and 22, which he testified were made at that time. On cross-examination Johnson testified that neither of these seals came within the claim of the patent (R. p. 271). Appellant closed its case without offering any explanation. The testimony was given in the District Court in January, 1946. Appellant waited until May, after Appellee's Brief in the Court below was on file, and then made a motion to reopen the proofs in order to show that plaintiff's exhibits 21 and 22 were not at the time of trial of the same shape as when made (R. p. 25).

Appellant's effort to mend its hold by reopening of proofs failed. The burden of proof is on the party seeking to carry back his date and the burden is a heavy one.

*Clark Thread Co. v. Willimantic Linen Co.*, 140  
U. S. 481, 492, 35 L. Ed. 521 (1890)

The Appellant undertook the burden of proving that in 1935 it made and successfully tested seals covered by the claim of the Johnson patent. Johnson produced the two seals (R. p. 235, 236). Even when his attention was called to the fact that these seals did not respond to the claim of the Johnson patent (R. p. 271), he did not testify that as originally made the seals did respond. He had testified that other samples were made in 1935 and that "they were all just the same as" plaintiff's exhibits 21 and 22 (R. p. 267). On the reopening of proofs, Johnson was not called. The only witness called to testify about the original shape of the exhibits on the reopening of proofs was Klein. Klein testified from memory that in making the seals some eleven years earlier, he had buffed them after they came out



of the mold so as to bring the back side of the sealing element within the cup (R. p. 405). Klein testified that there had been a change in shape due to "aging and cold flow" (R. p. 405). His opinion on this was shown on cross-examination to be of little value. For example, when asked as to how fast the Thiokol of the sealing element would change shape and how much change would take place in three years, Klein testified (R. p. 435) "I cannot answer that one. You will have to ask our chemist about that." When Stewart, a chemist and Appellant's Director of Research, was later asked about this, he testified (R. p. 483)—"I am not qualified to say. I could not estimate at all."

Plaintiff did not meet its burden of proof in showing that any seal made in 1935 embodied the Johnson claim. The only seals extant, plaintiff's exhibits 21 and 22, did not come within the claim. Of all of those who would have had knowledge of the shape of those seals in 1935, only Klein was called to testify.

Another defect in plaintiff's endeavor to prove a reduction to practice in 1935 is plaintiff's failure to show that it tested any seal so as to prove that it would perform its intended function under actual service conditions by concrete, visible, contemporaneous proofs which speak for themselves.

See *Emerson & Morris Co. v. Simpson Bros. Corp.*,  
202 Fed. 747, 750 (C. C. A. 1, 1913) cert. den. 235  
U. S. 707.

In addition to proof that a device coming within the claim of the patent was made, one seeking to show a reduction to practice must prove that it performed its intended function under actual service conditions. Depending upon what the device is, such tests may or may not be

performed in the laboratory. There are many decisions by all federal courts on this point. We quote two of the best statements of the rule. In *Chittick v. Lyons* 104 F. (2d) 818, 820 (Court of Customs and Pat. App. 1939) the Court (Opinion by Judge Garrett) said:

“That laboratory tests may constitute reduction to practice, under some circumstances, is so well settled that citation of authorities upon that point is deemed unnecessary. Such tests, however, must simulate actual service conditions with sufficient clearness to render it reasonably certain that the subject matter will perform its intended function in actual service.”

In *Henderson v. Gilpin* (C. D. 1913, 310; 187 O. G. 231; 39 App. D. C. 428) the Court said:

“It is not enough, as contended by appellant, that these shop tests indicated that the operation of the device would be successful. To constitute reduction to practice the test must amount to a demonstration in fact, as contradistinguished from one in theory.”

The application of these principles to an oil seal is illustrated in *Chicago Rawhide Mfg. Co. v. National Motor Bearing Co.*, 50 F. Supp. 458 (D. C., N. D. Cal. S. D., 1943). That was a suit brought by Chicago Rawhide after an interference was terminated favorable to National Motor Bearing. The plaintiff urged that it had reduced to practice prior to the defendant, and the defendant argued that the plaintiff's alleged reduction to practice was not sufficient because the test was inadequate. The Court called attention to the fact that the plaintiff (as the plaintiff herein) relied upon witness recollections without records of the test. The Court in its opinion described the tests in some detail. They were more thorough than Johnson's appear to have been. The Court held them insufficient, saying at page 461:

“Plaintiff’s invention is an essential structural element of a general utility oil seal. Oil seals are used on moving shafts to keep the lubricant in and foreign matter out. In order to do this the sealing lip must fit tight against the shaft at all speeds and under the stresses and strains that it is normally subjected to. Failure to do so might have disastrous consequences. Witnesses testified that because the seals are such vital parts of the mechanisms in which they are used, no user would buy a new type without testing it under actual working conditions. It seems clear, therefore, that a test that falls short of imposing on the seal the strains and stresses it would encounter in actual operation is insufficient to constitute reduction to practice.”

The tests alleged to have been performed by Johnson are defective in several respects, but primarily in failing to demonstrate that the rim of the cup would protect the molded material of the sealing element from wear by contact with adjacent moving parts. Klein admitted that in the test there was no adjacent moving part. (R. p. 423). Since the claim specifically calls for this function to be performed by the cup bottom, whatever else a reduction to practice might require, the test should determine that the seal would function in this manner. This is particularly true in view of Aukers testimony at the trial that any contact of the thin metal of the cup with adjacent moving parts would result in immediate or more rapid failure of the seal (R. pp. 186-188).

Moreover, Appellant did not establish with the required certainty what was done in the inadequate tests. Johnson and Klein both agreed that exhibit 21 was tested and exhibit 22 was not (R. pp. 235-236, 424). How long did the test of Exhibit 21 continue? Johnson said 72 hours (R. p. 267). Klein said “a little over a month.” (R. pp. 402, 423). In addition to this, whatever proofs the Appellant might have produced as other tests in 1935, no reduction to practice could be established since plaintiff’s Director of Research,

Stewart, testified that in his opinion the Thiokol material used by Johnson in the alleged reduction to practice was not operable at all in an oil seal (R. p. 473). Stewart further testified that in view of the cold flow of this material, it could not possibly stay within the tolerances set (R. p. 494-495) and that even the improved forms of Thiokol, which are known today, are not operable in oil seals, and the form known in 1935 was much worse (R. pp. 495-496).

Appellant wholly failed to prove a reduction to practice of the structure of the claim of the Johnson patent in 1935. The earliest date to which Johnson is entitled is the filing date of the application, August 5, 1936. Even this date might properly be contested since this claim, adding for the first time the whereby clause, was added in the last amendment on November 18, 1938 (R. p. 632). The accused seals were offered for sale and some of the Type A seals were actually sold in July, 1936 (R. pp. 189-195, 768-770). They are, therefore, part of the prior art so far as the Johnson patent is concerned. Under these circumstances whatever view be taken as to infringement, there cannot be a finding of both validity and infringement.

**The District Court Properly Found that the Johnson Patent Required Nothing More than Ordinary Mechanical and Engineering Skill and Was Lacking in Patentable Novelty and Invention** (Appellant's Opening Brief pp. 23-28).

The finding by the District Court (R. p. 58) that the structure of Johnson required nothing more than ordinary mechanical and engineering skill and was lacking in invention is a finding of fact.

*Williams Manufacturing Co. v. United Shoe Machinery Co.*, 316 U. S. 364, 367, 86 L. Ed. 1537 (1942);

*Crowell v. Baker Oil Tools, Inc.*, 153 Fed. (2nd) 972 (CCA 9, 1946)



The finding is amply supported by the evidence and is not clearly erroneous.

The Appellant (Opening Brief pp. 23 to 25) alleges seven "facts" which are said to be "established." It is significant that none of these alleged "facts" were found to be such by the District Court. Further, none bear any relation to the Johnson patent claim and its functional "whereby" clause.

The first of the "facts" alleged by Appellant is that the structure of the Johnson oil seal was new with Johnson. The District Court found the contrary. (R. pp. 57-59). At pp. 8 to 25 hereof, we have shown that the evidence fully supports the District Court's finding.

The second assertion of alleged "fact" by Appellant (Br. p. 23) is that the accused seals "are substantial Chinese copies" of Figs. 1 and 5 of the Johnson patent. Since it is the claim of a patent which controls (*Universal Oil Prod. Co. v. Globe Oil & Ref. Co.*, 322 U. S. 471, 484, 88, L. Ed. 1399, 1407), there is no relevance in this assertion even if it were true. However, the record shows that the accused seals were on sale in July, 1936 (R. pp. 189-195, 768-770), and Figs. 1 and 5 of the Johnson patent are not shown to have been in existence prior to the filing of the patent application in August, 1936. Thus, the alleged *copies* were on sale and were part of the *public knowledge* prior to the time that the alleged *originals* existed, even in the secret files of the Patent Office. So far as the claim of the patent is concerned, it came into existence some two years later by amendment in November, 1938. By this time the accused seals had been advertised and sold and Johnson had knowledge of them (R. pp. 271-272).

The third "fact" alleged by the Appellant (Br. p. 23) is that the practical value of Johnson's invention is established by the commercial success of Victor seals alleged



to be copies, even though plaintiff "for its own good reasons" never sold any Johnson seals. In this connection, Appellant refers to the case of *Smokador Manufacturing Co. v. Tubular Products Co.*, 31 F. (2d) 255 (CCA 2, 1929) in which the Court, in its opinion by Judge Augustus Hand, stated that on the facts there involved, sales by the defendant were a tribute to the value of the invention, even though the plaintiff had not manufactured and sold under its patent. On the facts of that case, a tribute by the defendant might properly be inferred, but the facts are quite different from the instant case. The defendant in that case was an admitted infringer who had bribed an employee of the plaintiff to get the design of the plaintiff's ash stand, and promptly copied. The facts in the instant case are quite different. Here the accused seals were on sale before Johnson's patent application was filed, and were designed independently. *Johnson had knowledge of the accused seals before he submitted his final claim to the Patent Office* (R. p. 272). If copying exists in the case at bar, it is in reverse. Furthermore, while the Appellant lightly casts aside its own failure to use the patent "for its own good reasons," on the question of invention it is interesting to see what those "good reasons" were. The record shows that the Appellant, claimed by Johnson to be the second largest company in the field, and the Chicago Rawhide Company, claimed by Johnson to be the largest producer of oil seals (R. p. 290), manufactured under another patent (R. p. 281). The Appellant uses clamping. The explanation of non-use by Johnson was that from 1935 until 1939 the patent had not issued (R. p. 82). After the patent issued, Johnson testified that the Appellant did not make the Johnson seals because Victor was making them (R. p. 71). Even in 1940 and 1941, when building two new large plants, the Appellant put in machinery to make seals under a Chicago Rawhide patent rather than to put in machinery

to make seals under its own patent (R. pp. 70, 88-89, 281). The fact that the Appellant continued to make prior art seals and did not consider the structure of the Johnson patent of sufficient merit to warrant a change in equipment, and the fact that, even when building two new plants, the Appellant preferred to continue manufacture under another company's patent rather than to use its own, do not indicate that Johnson made a contribution to the art. The fact that the Victor company has made substantial sales of the accused seals indicates that they are good products, but does not show that their merit is in any way connected with the Johnson patent.

The fourth "fact" alleged by Appellant (Br. p. 24) is that Johnson seals have a new mode of operation in that the flexible sealing member is not under compression as held in the cup member and, therefore, is not subject to cold flow. This subject has been fully discussed hereinbefore (pp. 8 to 10). An oil seal will or will not be subject to cold flow depending upon the material of which the sealing element is made. Johnson neither discovered nor received a claim on this. If there was any invention in cementing or molding instead of clamping, this was made prior to Johnson. As pointed out at page 16 of this brief, the Johnson patent shows the equivalency of clamping the sealing element between two layers of metal and "clamping" a layer of metal between two portions of the sealing element.

The fifth "fact" alleged by Appellant (Br. p. 24) is that Johnson was the first to maintain a rubber or rubber-like sealing member in permanent, fixed, leak-tight engagement in the cup and to fix the sealing lip in correct position on the shaft and in relation to the cup. This assertion is without support in the record. Johnson made some sample seals in 1935, only two of which were preserved, neither of which was tested in contact with an adjacent moving part

as required by the claim, only one of which was tested at all—and it for an unknown period—and both of which had sealing elements made of a material admitted by Appellant's Director of Research to be inoperable in an oil seal. Johnson contributed nothing. Both Gits and Victor had oil seals on sale with synthetic sealing members prior to Johnson's patent application. Johnson's patent application left the oil seal art as it found it—save for the contribution of some misinformation as to the protection of the sealing element from wear by contact with adjacent moving parts. Even this misinformation was based upon a structural feature old in many patents. (See page 11 hereof.) Johnson's patent joined the thousand or more unused ones in the art (R. p. 241). If the Johnson patent structure had the merit attributed to it by Appellant, it should have displaced the prior art clamping—at least in Appellant's manufacture (R. p. 281). Appellant's non-use of the Johnson patent is inconsistent with its eulogy in this case.

As a sixth "fact", Appellant alleges that there was a recognized demand, that the art struggled for years, and the struggle resulted only in failure for want of Johnson's conception. The record fails to support this assertion. It is true that as the synthetic materials became available in the early 1930's, in not yet developed form, those seeking to employ them had some difficulties in adaptation. Gits, in 1933 for example, the first to endeavor to employ Koro-seal in such an application, required considerable experimentation. It is also true that Johnson had difficulty with the synthetic material and ended up using Thiokol, which Appellant's Director of Research admitted is inoperable (R. p. 473). But the struggles of the prior art were not in vain and to this day, so far as the record shows, the two largest manufacturers, including Appellant, make the prior art leather seals under a prior art patent. There are at

least five "good-sized" companies making oil seals who have found no use for the Johnson patent (R. p. 289-290).

The seventh "fact" alleged by Appellant is that the Victor company took out some improvement patents and, therefore, it comes with bad grace for the Victor company to contend that the Johnson seal lacks patentability (Appellant's Opening Brief pp. 24-25). However, this does not mean that the Victor Company seals come within the Johnson claim or that the Johnson claim is valid.

On pp. 26 and 27 of its Brief, the Appellant quotes short excerpts from four decisions of the Supreme Court. None of these decisions is on facts approximating those in the case at bar. In *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U. S. 45, 67 L. Ed. 523 (1923) the Court, in its opinion by Mr. Chief Justice Taft, called attention to the evidence which showed that Eibel had "advanced the art substantially." Among other things the evidence in that case showed that the patent there involved increased production by at least 20%. Over two-thirds of the industry were licensees under the patent and most of the remainder of the industry were infringers contributing to a defense fund to resist suits under the Eibel patent. In the instant case, the facts are far different. By the testimony of Johnson, there are seven companies in this country making oil seals of the general type here involved (R. p. 289). Of these, only the Victor Company is alleged to be using the Johnson invention. It does not use the Johnson structure and the Appellant prefers to manufacture under another patent owned by another company.

In the *Barbed Wire Case*, 143 U. S. 275, 36 L. Ed. 154 (1892), the Supreme Court, in its opinion by Mr. Justice Brown, a few sentences prior to the statement quoted by Appellant (Br. p. 26), called attention to the fact that the sales under the prior art patent closest to the Glidden patent there in suit never exceeded 3000 tons per year and



that the sales under the Glidden patent had reached 173,000 tons per year. The court pointed out the fact of common knowledge that the barbed wire fence of the patent in suit had enabled the fencing of a very large portion of the Western plains which otherwise would have had to be unfenced. No such showing was made by the Johnson patent here in suit.

In *Diamond Rubber Co. v. Consolidated Tire Company*, 220 U. S. 428, 55 L. Ed. 527 (1911), the Supreme Court, in its opinion by Mr. Justice McKenna, pointed out that the patented tire there involved had secured "almost universal acceptance." Far from universal acceptance, the Johnson patent significantly is not used even by its owner, the Appellant.

In *Sinclair & Carroll Co., Inc. v. Interchemical Co.*, 325 U. S. 327, 89 L. Ed. 1644 (1945), from which the Appellant quotes at page 26 of its Brief, the Supreme Court held invalid claims on a printer's ink. The Supreme Court pointed out that many efforts were made to eliminate the necessity of a delay of from one to 24 hours after printing one side of a sheet of paper before printing the reverse side. The Court pointed out that the problem was complicated. The Court further pointed out that since the disclosure by the patentee, his ink or similar infringing inks had been used to print *The Saturday Evening Post*, *Colliers* and *The New Yorker*. However, the Supreme Court held that the patentee had not made an invention. The Court said in its opinion by Mr. Justice Jackson at p. 327:

"Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put into the last opening in a jig-saw puzzle. It is not invention."

This case to which Appellant has directed attention presented a strong record for validity. It was well established that a real problem existed and it was well established that



the patentee solved the problem. It was also well established that the patented improvement was immediately adopted by substantial companies in the industry. Even then the Supreme Court held the patent invalid because the elements which had been combined by the patentee were all elements with known qualities, combined to produce a result that could have been predicted. In the case at bar, there is no proof whatsoever that the patent in suit solved any problem. Indeed, the testimony shows that the structure of the Johnson *claim* is valueless.

It has been shown hereinbefore (pp. 11 to 25) that the Johnson claim is anticipated by a plurality of prior art seals. However, assuming for the sake of argument that what Appellant here asserts is true and that Johnson did overcome problems of cold flow by molding the sealing element to the cup member rather than by clamping it, there would still be no invention. Prior to Johnson it was known that a sealing element could be molded to a metal flange (See, for example, Penick Patent No. 1,817,095, R. p. 660). If using a synthetic material which would cold flow, instead of leather used by Winter No. 2,089,461 (R. p. 714), for example, the man skilled in the art could substitute the known method of securing of Penick for the clamp shown by Winter. If the oil seal manufacturer desires to mold and vulcanize in his own plant, he can do so after the synthetic material is in contact with the flange as Johnson suggests and as earlier suggested by Penick. If the oil seal manufacturer desires to purchase the synthetic sealing elements already vulcanized by the source of supply, he can do so as Gits did. There is no invention involved in doing it one way instead of the other. "The choice was one between alternative means obvious to any mechanic; it did not have the quality of invention."<sup>1</sup>

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<sup>1</sup> *Essex Razor Blade Corp. v. Gillette Safety Razor Co.*, 299 U. S. 94, 98, 81 L. Ed. 60 (1936).

There are numerous illustrations of this principle in the decided cases. Each decision, of course, turned upon the facts of the particular case. Since the question of invention is a question of fact, no "authority" can be cited to sustain a fact finding. However, to indicate that the District Court herein in finding no invention was consistent with previous decisions of this Court and the Supreme Court, we call attention to the following cases:

*Grayson Heat Control v. Los Angeles Gas Appliance Co., Inc.*, 134 F. (2d) 478, 481 (1943);

*Magarian v. Detroit Products Co.*, 128 F. (2d) 544 (C. C. A. 9, 1942).

*Mantle Lamp Co. v. Aluminum Products Co.*, 301 U. S. 544, 547, 81 L. Ed. 1277 (1937).

**The District Court Properly Found that the Appellant Was Guilty of Laches** (Appellant's Opening Brief pp. 28-31).

The Appellant is correct in calling attention to the typographical error in Finding VIII (R. p. 58). The accused structures admittedly were on sale beginning in July, 1936 and not 1935. The exact date when the sale of the accused devices began is not of significance so far as the question of laches is concerned. The patent issued in 1939. The Appellant admittedly had knowledge of the accused devices prior to the issuance of the patent. In the same month in which the patent issued, the Appellant purchased accused seals from the defendant. Neither at that time nor thereafter did plaintiff make any charge of infringement to defendant until the complaint was filed on September 18, 1944. This delay of five and one-half years to even notify the defendant of infringement when defendant was selling a product which had been on the market for several years prior to the issuance of the patent constituted laches.

The Appellant seeks to justify the delay by asserting that it endeavored to settle with the Victor Company and did not give up hope of settlement until 1940 (Appellant's Opening Brief p. 28). These negotiations were proved by defendant's witness, Gammie, whose testimony was based upon a memorandum made at the time (R. pp. 203-206). The Victor Company suggested that the patent in suit might have nuisance value of \$1500 or \$2000 and Johnson countered by quoting such sums as "chicken feed." Johnson thought the patent was worth \$10,000 (R. p. 204). Johnson said he would prefer to keep the patent "for trading purposes later on." That constituted the negotiations. Neither then nor when Johnson said he gave up hope of settlement in 1940 (R. p. 74) did Appellant charge Appellee with infringement.

At p. 29 of its Brief, the Appellant seeks to justify this delay because of the war. It is not denied that patent litigation might properly be postponed to further the progress of the war; however, the war effort would not have been impaired by the sending of a notice of infringement to the defendant. Further it should be noted that in September, 1944, when the complaint was filed herein, this country was still at war both in Europe and in the Pacific.

The finding of laches by the District Court, though clearly supported by the evidence, was not needed to compel the dismissal of plaintiff's complaint, since the findings as to anticipation and lack of invention required this.

**The Johnson Patent Is Invalid Because Issued to Johnson Alone When, at best, It Is a Joint Invention of Johnson and Klein.**

Appellant's witness, Klein, testified that he made the sketch, Exhibit 20, from his own imagination (R. p. 417). He later testified that he did this work in collaboration

with Johnson and that they did it together (R. p. 418). On redirect examination he testified that his contribution was the bonding of the sealing element to the case to make a two-piece oil seal out of it (R. p. 441). Again, at record p. 443, Klein testified that the outer case was suggested by Johnson and the bonding of the material to the case was suggested by Klein. Finally, at R. pp. 442-443, Klein testified:

“Q. Counsel for plaintiff asked you regarding certain elements. Now, I wish you would tell us without the patent claim before you what elements you presented and what elements Mr. Johnson presented? Just tell us.

A. We were working on the development of the simplest possible type of synthetic oil seal with the least possible number of parts and the lowest possible manufacturing cost.

In connection with that the outer case was suggested by Mr. Johnson *and the bonding of the material to the case was presented by myself* and illustrated in this sketch, Exhibit 20. (Italics supplied.)

In addition to the contouring of the seal I sketched a cross-section, a small portion of the cross-section of the mold, pointing out the advantages of such a seal and showing how it could be molded. That just about covers it.”

It is submitted that Appellee's position hereinbefore taken, that there is no novelty and no invention in the Johnson patent is sound; but if there were any element contributed in molding the synthetic material to the cup, it came from Klein and not from Johnson. Even if Johnson rose to the stature of co-inventor by his suggestion of the outer case (which was old), the patent is void.

*Tin Decorating Co. v. Metal Package Corp.*, 37 F. (2d) 5, 7 (C.C.A. 2, 1930) cert. den. 281 U. S. 759.



### CONCLUSION.

The Johnson patent in suit is clearly void for lack of novelty and for lack of invention over the prior art. It is invalid on the prior use by Gits. It made no contribution to the art. It has never been used—even by the plaintiff, who prefers to make oil seals under a patent licensed to it by another manufacturer of oil seals.

It is very limited in its scope by the requirement that the molded material be protected by the cup bottom from wear by contact with adjacent moving parts. This element is not found in defendant's device. For this reason alone there is no infringement. Further, the defendant's device was on the market before the Johnson application for patent was filed, and it was not proved that Johnson made his alleged invention prior to his filing. For this reason also there can be no infringement, even if a false postulate of validity is made.

The District Court's findings are overwhelmingly supported by the evidence. Further, the plaintiff itself proved that Johnson is not the inventor of the patent's claim. It is submitted that the judgment appealed from should be affirmed.

Respectfully submitted,

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